

REMARKS

Claims 1 through 8 are pending in this application. Claims 1, 6 and 8 have been amended by this Amendment After Final.

Claim Objection under 35 U.S.C. § 112

Claim 6 was objected to because of the informalities pointed out by the Examiner, by which the fourth and eighth means appeared to be the same. Claim 6 has been amended to clarify that the fourth and eighth means are intended to be different, since the eighth means operates only after the seventh means has written new data/information. It is therefore submitted that claim 6 has now been amended to overcome the Examiner's § 112 objection. Accordingly, withdrawal of the objection to claim 6 is respectfully requested.

Claim Rejection Under 35 U.S.C. §102

Claims 1, 2, and 6 through 8 were rejected under 35 U.S.C. §102(e) for alleged anticipation by Jones U.S. Patent No. 5,572,660. These claims have been further amended to emphasize that there is a unique one cache corresponding to a unique one disk, unlike Jones. Therefore, it is submitted that Jones does not anticipate the instant invention, since Jones does not disclose each and every element and limitation of these claims. Withdrawal of the § 102 rejection of claims 1, 2, and 6 through 8 is respectfully requested.

Claim Rejection Under 35 U.S.C. §103

Claims 3 through 5 were rejected under 35 U.S.C. §103(a) for alleged unpatentability over Jones '660 in view of Holland U.S. Patent No. 5,455,934.

a. The preceding remarks about the lack in the cited art of a unique cache and unique disk relationship are incorporated herein by reference.

b. The § 103 rejection based on combining Jones and Holland is not supported by a specific showing of a teaching, suggestion, or motivation in the prior art to combine Jones and Holland. Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)(teaching or motivation or suggestion to combine is an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998); *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072 (Fed. Cir. 1994)(“When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.”); *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943–44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1586, 1589–90 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q.2d 929, 933 (Fed. Cir. 1984).

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability.” Doing that is “the essence of hindsight.”

In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The showing must be "clear and particular." Broad conclusory statements standing alone are not legally sufficient. *Id.* There must be "particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references." *Id.* at 1000. The PTO must explain, as it did not do here, what specific understanding or technical principle would have suggested the combination of references. *Id.*; *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998).


d. That it is advantageous to access from the outer track in this context, as the office action states, is not a basis for combining the references. It is a hindsight use of the instant disclosure to provide the requisite motivation instead of finding the same in the prior art. Nothing in the prior art *specifically* teaches, suggests, or motivates combining and adopting the Jones and Holland devices to correspond to the instant structure, so as to get the benefit of outer track access for accomplishing the purposes of the instant invention.

In view of the above, withdrawal of the § 103 rejection of claims 3 through 5 is respectfully requested.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this response.

Respectfully submitted,



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